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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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GROUP 1800

In re application of
Carol A. Westbrook

Serial No. 07/784,222

Filed: October 28, 1991

For: METHODS AND COMPOSITIONS FOR THE DETECTION OF CHROMOSOMAL ABERRATIONS

Group Art Unit: 1800

Examiner: L. Bennett (Arthur)

Atty. Dkt.: ARCD:010/PAR

CERTIFICATE OF MAILING
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on the date below:

May 17, 1994 — David L. Parker
Date

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REQUEST FOR RECONSIDERATION OF DECISION ON PETITION DATED APRIL 11, 1994, OR IN THE ALTERNATIVE, PETITION TO REVIVE FOR UNINTENTIONAL ABANDONMENT

Honorable Commissioner of
Patents and Trademarks
ATTN: Assistant Commissioner
Washington, D.C. 20231

Sir:

This paper is filed to request that the PTO reconsider the Decision on Petition dated April 11, 1994 rendered in the referenced case, based upon the following clarifications. It will be recalled that the referenced application was abandoned by the PTO based on its allegations that no response was filed to a Notice to Comply with Sequence Requirements.

From the Decision (copy enclosed) it appears that the PTO's refusal to grant Applicants' original petition was based upon: (1)

the PTO's finding that no response was filed by Applicant to the original Notice to Comply, and (2) that the referenced patent specification does in fact contain sequence information covered by the PTO sequence disclosure rules. Applicant requests reconsideration of this holding in light of the following information.

First, the PTO's decision to hold the application abandoned was based principally upon its allegation that no official response was filed to the Notice to Comply. While the Decision appears to recognize that Applicant's letter dated August 6, 1992 constituted such a response, it was nevertheless held that this was not sufficient because an official copy of the August 6th letter was not found after a search of the PTO files, and Applicant's copy of the August 6th letter failed to include a facsimile receipt. The PTO thus does not accept Applicant's verified statement as evidence that the letter was facsimile-filed with the PTO on August 6, 1992.

In response, Applicant presents further proof that the August 6, 1992 response to the Notice to Comply was filed with the PTO. Attached as Exhibit A is a copy of a facsimile transmittal receipt showing that the August 6, 1992, response to the Notice to Comply was transmitted on that date to the Applications Branch at 703-308-2840 (it is noted that the denotation at the bottom of the confirmation sheet indicates the telephone number as being 703-557-7120, and this is presumed to be the former number of the Applications Branch fax). It is respectfully submitted that this

additional evidence makes it clear that the August 6, 1992 response was filed with the PTO on that date.

It should be recalled that the original Notice to Comply received from the PTO did not point out the nature and location of the sequence that was being subject to the sequence listing requirement. Moreover, Applicant's representative was unable to locate and identify in the specification the sequence that was being subject to the requirement. This was the reason the Applications Branch, and later Examiner Bennett, were contacted, so that they could point out to us the sequence(s) being subject to the requirement. As pointed out in the original and supplemental declarations of Dr. Fussey, Examiner Bennett informed us that she also reviewed the application and was unable to identify the sequences either.

Additional evidence in the form of memoranda to our files indicate the significant contact that Applicant maintained with Examiner Bennett in connection with the referenced requirement in this case, and how Examiner Bennett's representations to Applicant resulted in potential harm to Applicant should the PTO maintain its position on the issue of abandonment. These memoranda further demonstrate Applicant's reliance on Examiner Bennett's representations that 1) she had determined that no sequence listing was required; and 2) that she had contacted the Applications Branch to advise them of this finding.

The Exhibit B document is a memorandum to our file prepared by Dr. Fussey dated May 8, 1992, demonstrating that the sequence

requirement was discussed with Examiner Bennett and that she indicated to us that she would review the file and get back to us.

The Exhibit C document is a second memorandum from Dr. Fussey to our file dated June 3, 1992, indicating that Examiner Bennett informed us that a sequence disclosure was not necessary. In this memorandum, it is further indicated that Examiner Bennett informed us: 1) that she had already informed the Applications Branch of her opinion that no sequence requirement was needed and 2) that we should simply respond to the Notice of Sequence Requirement by sending a letter to the Applications Branch to that effect. As evidenced by the August 6, 1992 documents set forth in Exhibit A, the Examiner's express requirements to us were followed.

Also attached to the memoranda in both Exhibit B and Exhibit C are data from our computer records to show that both of these records were created on or about the dates in question in May and June of 1992. It should be noted that neither of these records have been retrieved or revised since their creation during the months of May and June, 1992.

Thus, in light of the foregoing it is submitted that Applicant made every reasonable attempt to comply with the sequence listing requirements. Applicant's representative relied upon the oral representations of PTO Examiner Bennett in seeking to comply, and, contrary to the Decision, a formal reply was filed precisely in accordance with the dictations of Examiner Bennett.

The Decision is also apparently based on the position that Examiner Bennett was never formally assigned this file. In

response to this position, Applicants enclose an additional declaration of Dr. Shelley Fussey (Exhibit D) who states that on or about the time that the original sequence listing requirement was received, Dr. Fussey telephoned the Applications Branch to find out where the sequence was in the application that gave rise to the requirement. Dr. Fussey was informed that the application was assigned to Lisa Bennett, and that any questions regarding the issue should be addressed to Examiner Bennett. Moreover, according to the Fussey declaration, when Examiner Bennett was subsequently contacted, she informed Dr. Fussey that she had the application file in question in her possession, indicating to the Applicants that the file had in fact been transferred to her.

Evidence in support of the conclusion that Examiner Bennett was assigned the file is set forth in Exhibit E. Exhibit E is a telephone log that includes telephone calls made from the extension of Dr. Fussey (4276) to telephone numbers at the Patent and Trademark Office. First, it lists a May 8, 1992, telephone call to 703 308 0917, which number corresponds to that listed for the Application Processing Division on the Notice to Comply (copy enclosed). Second, there is a call from Dr. Fussey's extension to 703 308 3988 listed on June 2, 1992. This corresponds to the telephone number for Examiner Bennett recorded on the memorandum of Dr. Fussey, dated June 3, 1992 (Exhibits C and E). The discrepancy of one day between the telephone log and the memorandum is presumed to have arisen due to a simple oversight in preparation of the memorandum, either in drafting or in storing

the document on the computer system.

Thus, while the PTO appears to now be taking the position that the application was never assigned to Examiner Bennett, the fact is that the Applications Branch informed us that Examiner Bennett was assigned the application, that she should be contacted for instructions, and we relied on this representation, potentially to our detriment.

Therefore, while the Decision says that any such statements made by the Examiner would not relieve Applicant of the duty to respond, the fact of the matter is, Applicant did file a response, and made every reasonable effort to comply with the requirement: a statement as suggested by the Examiner was filed, and we were specifically informed by Examiner Bennett that no other response was required.

In the referenced Decision it has been brought to Applicant's attention that the specification does contain sequence information at pages 37 and 38 that fall within the requirements of the sequence disclosure rules. Applicant apologizes for its oversight in failing to earlier identify the location and nature of the sequence being subject to the requirement, and respectfully requests that now that the nature and location of the sequence has been identified, that the enclosed sequence listing documents be accepted and made of record in the case. A copy of the sequence listing is enclosed herewith (Exhibit F), and the original sequence papers and diskette are being filed concurrently directed to the attention of BOX SEQUENCE. It is believed that such

documents bring the application into complete compliance with the sequence listing rules.

If the present request for reconsideration of the Decision on Petition is denied for any reason, Applicants alternatively petition for the revival of the application under 37 C.F.R. § 1.137(b). The present application became abandoned unintentionally, and a response to the sequence requirements is submitted herewith. This petition is being submitted within three months of the date of the first Decision on a Petition to Vacate the Notice of Abandonment. The first Petition to Vacate was filed within three months of the original Notice of Abandonment. Applicants have been diligent in communicating with the PTO during this period and have responded in writing to communications from the PTO in a timely manner.

If this Petition to Revive is deemed necessary, the Commissioner is hereby authorized to deduct the amount of $1,170.00, as stated in 37 C.F.R. § 1.17(m)(1), from Applicant's deposit account No. AWD 01-2508/ARCD:010/PAR.

Respectfully submitted,

David L. Parker
Reg. No. 32,165

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Date: May 17, 1994

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